

REMARKS

This Amendment is in response to the Office Action mailed July 18, 2008. With this Amendment claim 12 is amended and the remaining claims are unchanged. Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

I. Claim Amendments

With this Amendment claim 12 is amended to more indicate that the steps of receiving and attaching as recited in the claims occur at network access device and not at the wireless client. This amendment is supported by the present specification at least at the paragraph beginning on page 10 line 13 of the Specification. Therefore, no new matter is presented. Entry is respectfully requested.

II. Rejections under §103

A. *Claims 1-8 and 31-33*

In item 6 of the Office Action claims 1-8 and 31-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nordman, U.S. Patent No. 6,061,346 (hereinafter "Nordman") in view of Brustoloni et al., U.S. Patent Application Publication No. 2001/0034831, (hereinafter "Brustoloni"). The Applicant has reviewed the cited references and must respectfully disagree.

In the Office Action the Examiner clearly states that the Brustoloni reference was filed after the filing date of the present application. Further the Examiner indicated that they are relying on the provisional filing date of the Brustoloni reference as the effective date under 35 U.S.C. §102(e) of the reference. However, the basis of the rejection relies on the published application and not the provisional application as filed. The Applicant

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notes that in order for the reference to be afforded its provisional filing date the relied upon disclosure must be disclosed in its entirety in the provisional application. If the relied upon disclosure is not in the provisional application it is only afforded the filing date of the non-provisional application.

In consideration of the possibility that the cited reference may have multiple priority dates, the Applicant reviewed both the cited reference and the provisional application in view of the rejections of record. In the rejection the Applicant notes that the Examiner refers to paragraph 39 of the Brustoloni reference and in particular phase 2 of paragraph 39. After reviewing the provisional application the disclosure of paragraph 39 is not present in the provisional application. Therefore, the Applicant respectfully submits that the Brustoloni reference has two priority dates, and at least a portion of the reference that was cited against the present claims was disclosed after the filing of the present application. Thus, the Applicant respectfully submits that Brustoloni reference as applied to the present claims is not prior art, and therefore, cannot be applied against the present claims in a §103 rejection.

Further on page 4 of the Office Action the Examiner states in the reasons for combining the references that "It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teaching of Brustoloni such as 'sending the assigned network address to the wireless client prior to establishing a secure link' within the system of Nordman in order to provide a secure, low cost, internet access at locations that are convenient for mobile clients and further enhance security of the system. [See Brustoloni paragraph 0009]." However, the section cited of Brustoloni to support this reasoning was not present in the provisional application. The asserted reasoning by the Examiner was disclosed not at the time of the applicant's invention, but at a time after the applicant's invention. Thus, the asserted rationale for combining was not known at the time of the applicant's invention. Therefore, the

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Applicant respectfully submits that there was no reason to combine the references at the time of the applicant's filing of the present application. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claims 12, 15 and 19

In item 12 of the Office Action claims 12,15 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Orsic, U.S. Patent No 6,147,986 (hereinafter "Orsic") in view of Ala-Laurila et al, U.S. Patent No. 6,704,789 (hereinafter "Ala-Laurila"). In view of the present amendments the Applicant respectfully disagrees.

Claim 12, as amended recites, "receiving a request for a network address from the wireless client at a network access point; attaching at the network access point...." In the Office Action the Examiner asserted that Orsic disclosed these features of the claims. However, in Orsic, the request is generated at the mobile device and includes information related to the mobile device's identity (domain name and unique hardware address). This information is added to the request at the mobile device. In contrast, in the present claims the information is attached to the request at the network access point and not the mobile device. Further, with reference to the present Specification the information added to the request does not include the information that is added in Orsic. In particular, the Specification of the present application clearly indicates that the MAC (unique hardware address) is part of the request that is sent from the mobile device to the network access point. See paragraph starting at page 10 line 13. Therefore, this information cannot be attached to the request at the network access point as it already is in the request. The addition of Ala-Laurila does not remedy this deficiency of Orsic. Thus, the Applicant respectfully submits that the cited combination does not disclose all of the features of claim 12 in its entirety. Therefore, claim 12 is believed allowable over the cited combination. Dependent claims 15 and 19 are

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believed allowable as well, at least by virtue of their dependency from claim 12. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Claims 13, 14, 16 and 20

In item 13 of the Office Action claims 13, 14, 16 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Orsic, in view of Ala-Laurila in further view of Inoue et al. U.S. Patent No. 6,510,153 (hereinafter "Inoue"). The Applicant has reviewed the cited combination and respectfully disagrees. In particular dependent claims 13, 14, 16 and 20 depend from independent claim 12. As discussed above the combination of Orsic and Ala-Laurila does not disclose the features of claim 12 in its entirety. The addition of Inoue does not remedy the deficiencies identified above. Therefore, the Applicant respectfully submits that claims 13, 14, 16 and 20 are allowable over the cited combination at least based on their dependency from claim 12. Reconsideration and withdrawal of the rejection are respectfully requested.

III. CONCLUSION

Accordingly, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the prior art and that all the rejections to the claims have been overcome. Reconsideration and allowance of the pending claims are respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,
Microsoft Corporation

Date: October 20, 2008

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October 20, 2008
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/Noemi Tovar/
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